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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,250	06/22/2006	Glen R. Nemerow	5410-007 NATL	5019
7590 LISA A. HAILE, J.D., Ph.D. DLA PIPER US LLP Suite 1100 4365 Executive Drive San Diego, CA 92121-2133			EXAMINER SAJJADI, FEREDOUN GHOTB	
			ART UNIT 1633	PAPER NUMBER
			MAIL DATE 02/01/2010	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

<b>Application No.</b> 10/560,250	<b>Applicant(s)</b> NEMEROW ET AL.
<b>Examiner</b> FEREYDOUN G. SAJJADI	<b>Art Unit</b> 1633

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 26 January 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The Notice of Appeal was filed on 26 January 2010. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 58 and 80-85.  
Claim(s) withdrawn from consideration: 1-7, 10-54, 57, 59-68 and 72-79.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Fereydoun G Sajjadi/  
Primary Examiner, Art Unit 1633

Continuation of 3. NOTE: Applicants' proposed amendment of base claim 58 introduces the new limitation for SEQ ID NO: 49, not previously examined, requiring additional search and consideration of patentability. Applicants should further note that SEQ ID NO: 49 is a consensus sequence derived from Ad2, 5, 37, 8, 9 and 15 (See Figure 1B of the specification). An adenovirus cannot at once have a fiber shaft protein sequence of SEQ ID NO: 49, and the Ad37 fiber shaft protein sequence set forth SEQ ID NO: 48, as recited in dependent claim 82.

Continuation of 11, does NOT place the application in condition for allowance because: Entry of a proposed amendment after final rejection cannot be made as a matter of right unless it merely cancels claims or complies with a formal requirement made earlier. The examiner maintains the rejection of claim 58 under 35 U.S.C. §103(a) as being unpatentable over Vigne et al. (U.S. Patent No.: 6,455,314; effective filing date: Aug. 27, 1998), in view of Hallenbeck et al. (U.S. Patent No.: 2002/0137213; effective filing date June 2, 2000); the rejection of claims 58, 80-82 and 84 under 35 U.S.C. §103(a) as being unpatentable over Vigne et al. (U.S. Patent No.: 6,455,314; effective filing date: Aug. 27, 1998), in view of Hallenbeck et al. (U.S. Patent No.: 2002/0137213; effective filing date June 2, 2000), as applied to claim 58 above, and further in view of Havenga et al. (U.S. Patent Publication No.: 2003/0017138; filed Jul. 7, 1999); and the rejection of claims 58, 83 and 85 under 35 U.S.C. §103(a) as being unpatentable over Vigne et al. (U.S. Patent No.: 6,455,314; effective filing date: Aug. 27, 1998), in view of Kaleko et al. (U.S. Patent Publication No.: 2004/0002060; effective filing date Jan. 24, 2002) for reasons of record.

On September 11, 2007 Applicants elected the invention of Group VIII that included base claim 58, directed to a modified last repeat of modified shaft fiber protein and fiber knob as set forth in SEQ ID NO: 48, i.e. the last repeat of Ad37 (serotype D) and its modified form. Thus, the proposed amendment encompasses a non-elected invention, constituting a shift from the invention previously elected and examined. The Office generally does not permit a shift to claiming another invention mid-prosecution (MPEP §819). Applicants' arguments are based at least in part on the proposed claim amendments. However as the proposed amendments have not been entered, the arguments are not found persuasive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FEREDYOUN G. SAJJADI whose telephone number is (571)272-3311. The examiner can normally be reached on 6:30 AM-3:30 PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached on (571) 272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.